CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claim 43 is added which is simply claim 17 directed to a "combination" instead of a "kit." Like claim 17, claim 43 finds support in paragraph [0006] of US 2002/0009754. This is the paragraph bridging pages 2-3 of the instant specification. There is the teaching there that the fluorescent dye and the masking dye may be used in combination. Applicants respectfully submit that this language not only supports combination claim 43, but also kit claim 17.

Claims 17-23 were rejected under 35 USC § 112, first paragraph, as claiming new matter. According to the Examiner, the specification fails to disclose or describe that the fluorescent dye and the masking dye are packaged in a kit. In response, Applicants point out that the term "kit" is preambular and, therefore, nonlimiting. Moreover, there is nothing about its use in claims 17-23, or, indeed, in the normal usage of the word that requires co-packaging. Instead, the Examiner simply has read a co-packaging requirement into the claims, where none exists. The specification in the paragraph bridging pages 2-3 and in Figure 2, for example, clearly teaches the fluorescent dye and the masking dye are used together. This is sufficient to support a "kit" claim. Clearly, Applicants had possession of such a "kit."

In case the Examiner still has problems with the word "kit," Applicants have added new claim 43, which is simply the kit of claim 17 claimed as a combination. Certainly, claim 43 finds clear support in the paragraph bridging pages 2-3 and Figure 2.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 17-21 and 23 were rejected under 35 USC § 103(a) as being obvious over Wan et al. ("Wan"), *J. Immunol. Methods, 162:* 1-7 (1993), in view of Cubbage et al. ("Cubbage"), U.S. Patent No. 5,582,982. In response, Applicants point out that the Examiner comments at the bottom of page 4 of the Office Action as follows:

> "Since Wan teaches a fluorescent dye attached to the cell as in the present invention, such fluorescent dye is inherently permeant to the membrane of the cell and detects a voltage across the membrane of the cell."

Applicants whole-heartedly disagree with this statement and the implications thereof. First, Applicants point out that ***if*** the fluorescent dye is ***attached*** to the cell, it ***cannot*** be permeant to the membrane of the cell. Second, the fluorescent dye recited in instant claim 17 and the claims dependent thereupon is ***unbound*** fluorescent dye which is ***not*** conjugated to a cell. See, for example, the instant specification at page 4, lines 20-23. Third, Wan's fluorescein conjugated E. coli particles cannot be regarded as a "fluorescent dye," and, thus, does not the terms of the present claims, and, in any case, such particles are clearly ***not*** permeant to the membrane of any biological cell. Indeed, Wan expressly teaches that the particles ***are taken up by phagocytosis;*** they do ***not*** permeate any biological membrane.

Further, Wan teaches in the second paragraph in the right-hand column on page 2

that this fluorescein conjugated E. coli particles ***were purchased already conjugated.*** So, Wan never had unbound fluorescein and, thus, never any membrane permeant fluorescent dye, as required by the instant claims.

The Examiner continues to ignore the fact that Wan's fluorescein is conjugated to E. coli particles. Such particles simply cannot permeate the biological membrane. Thus, Wan teaches they are taken up by phagocytosis.

The Examiner says that since the fluorescent dye of the present invention and the fluorescent dye of Wan are the same, it is inherent that Wan's fluorescent dye can permeate the cell membrane. This is simply incorrect. Applicants' fluorescein is not bound to E. coli, whereas Wan's is. Thus, the dyes are different, and, moreover, this difference is spelled out in the instant claims by requiring that the fluorescent dye is permeant, which is a property that Wan's dye does not have.

In order to make this difference crystal clear, Applicants have amended claim 17 to require that the fluorescent dye is present in a form that permits such permeation.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claim 22 was rejected under 35 USC § 103(a) as being obvious over Wan in view of Cubbage and further in view of Van Aken, U.S. Patent No. 5,489,537. In response, Applicants point out that this rejection was premised on the combination of Wan and Cubbage teaching and/or rendering obvious the basic features of main claim 17. However, Applicants have explained above why this is not, in fact, the case. Accordingly, Applicants submit that the Examiner should reconsider and withdraw this

rejection as well. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By _____

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